

REMARKS

Rejection under 35 USC 101

In section 1 of the Office Action, the Examiner rejects claims 2-4 and 17-18 under 35 USC 101, asserting that the claimed invention is directed to non-statutory subject matter because “the inventive concept in claim 1 (probably a mistake from the Examiner because there is no claim 1 pending in this application) only recites an abstract idea” and “all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma* (CCPA 197, USPQ 852 (1978)).” The Applicant respectfully disagrees.

In *In re Toma*, the court reversed a rejection as nonstatutory subject matter of a claim to a method of operating a digital computer to translate from a source natural language (e.g., Russian) to a target natural language (e.g., English). The court remarked that

“[The] mental steps rejection was not intended to form a basis for a new §101 rejection as the examiner apparently suggests.”

It appears that the Examiner suggests that the methods recited in the claims are only “**mental steps**” (“can be performed in the mind of the user”) and thus unpatentable. However, the Examiner cites *In re Toma*, which reaches a conclusion just the **opposite** from that suggested by the Examiner, because *In re Toma* concludes that it is improper to reject claims

under 35 USC 101 on the basis that the recited steps are only "mental steps".

Moreover, the Applicant disagrees that all steps of the claimed invention can be performed in the mind of the user or by use of pencil and paper. For example, claim 2 of the present application recites, in part,

"wherein the source requires knowledge of a key in which said document is encrypted in order to provide the said document";

"said key comprising a first portion, a second portion, a third portion, and a fourth portion";

"the consumer requests a specified document"; and

"the owner provides the source with the first and third portions of the key and provides a mediator with the fourth portion of the key, which can combine with the third portion of the key to generate a complete key..."

To perform the steps recited in claim 2, among others, several different entities (the consumer, the owner and the mediator) and several apparatuses or items (the document source, the payment, the first portion, second portion, third portion and fourth portion of the key) are involved. Thus, it can neither be performed in the mind of the user nor be performed by use of pencil and paper.

Furthermore, as the Examiner acknowledges, the recited method produces a **useful, concrete and tangible result** (e.g., enabling a consumer to obtain a document from an owner upon making a payment). Under the recent decision of *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ 2d 1596 (Fed. Cir. 1998), the 101 rejection should be overcome by this fact alone (that the recited

method produces a useful, concrete and tangible result).

Due to the reasons stated above, the Applicant believes that the claimed invention recites more than just an abstract idea and promotes technological arts. Thus, the Applicant believes that the claimed invention directs to proper statutory subject matter and the rejection under 35 USC 101 should be withdrawn.

Double Patenting

In sections 2-3 of the Office Action, the Examiner rejects claims 2, 4-7, 10-13 and 17-18 under the judicially created doctrine of double patenting over claims 1-9 of US Patent No. 6,446,051. Enclosed please find a terminal disclaimer, disclaiming the terminal part of the statutory term of any patent granted on the instant application. The Applicant believes that the double patenting rejection has been overcome.

The Applicant believes that all pending claims are in condition for allowance and reconsideration of this application is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account No. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account

no. 12-0415.

Enclosed please find a copy of Troy Guangyu Cai's Notice of Limited Recognition under 35 CFR 10.9(b) to prepare and prosecute patent applications wherein the patent applicant is a client of Ladas & Parry, and the attorney of record in the applications is a registered practitioner who is a member of Ladas & Parry.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C., 20231 on February 17, 2003

(Date of Deposit)


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(Name of Applicant, Assignee or Registered Representative)

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Respectfully submitted,


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